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| 09/641,184 | 08/17/2000 | Brian John Cragun | ROC920000064 | 5343 |

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| EXAMINER |
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QURESHI, SHABANA

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| ART UNIT | PAPER NUMBER |
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2155

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/641,184 | Applicant(s) CRAGUN, BRIAN JOHN | |
| | Examiner Shabana Qureshi | Art Unit 2155 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/7/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed September 7, 2004 have been fully considered but they are not persuasive for the following reasons.

Applicant argues that a clarification of the Examiner's rejection is needed; a prima facie case of obviousness has not been established; Kim makes no mention of recording user interactions by the event handler; and Kim does not teach that the event handler performs bookmarking.

Examiner respectfully disagrees the entire allegation as argued. Examiner, in her previous office action, gave detailed explanation of claimed limitation and pointed out exact locations in the cited prior art.

In response to applicant's argument on page 1, a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

In response to applicant's argument, to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in single invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in particular field, or from nature of problem to be solved;" *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -1181

"[q]uestion is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.* U.S. Court of Appeals Federal Circuit 221 USPQ 481 Decided Mar. 21, 1984 No 83-1178.

Examiner suggests that Applicant clarify the claims to suggest where the user interactions are stored (in the bookmark) and the type of user interactions involved in reaching the final destination. The claim is currently broad, as user interactions may be interpreted as any user interaction such as clicking on any link or button or even a user typing the remainder of a bookmark in order to reach the final destination. Examiner invites Applicant to request and interview for any remaining concerns.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this action.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-16, 18-23, 25-26, 28-36, 38-40, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al (6,212,522 B1) in view of Kim (US 6,546,002 B1).

Regarding claims 1, 10, 14, 16, 19, 20, 21, 25, 33, and 38, Himmel et al teach a method of generating a bookmark to resolve a desired resource, the method comprising the steps of:

- storing, as a first portion of the bookmark, a base network address indicative of the location of a first resource (column 1, lines 40-67; column 7, lines 23-29); and

- storing, in respective next portions of the bookmark, at least those user interactions necessary to resolve respective additional resources including a final resource comprising the desired resource (column 1, lines 40-67; column 7, lines 23-29).

As was well known to one of ordinary skill in the art at the time the invention was made, a bookmark contains a URL or network address, and a network address usually contains a compound address, that includes the base address, and subsequent navigations by the user separated by a slash. Himmel et al does not explicitly state that the URL includes the user interactions necessary to achieve the final destination. However, Kim teaches a controller 200 that is coupled to the input interface 110, which receives input commands via the input interface (column 10, lines 1-19). A list of the user interactions are recorded by an event handler (column 12, lines 39-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Himmel et al by incorporating user interactions so that a user could access specific bookmarks (column 4, lines 5-10).

As per claims 2, 15, 18, 22, and 39, Himmel et al teach the method of claim 1, wherein the network addresses comprise uniform resource locators (URLs) (abstract; column 7, lines 23-29).

As per claim 3, 23, 26, 35, and 40, Himmel et al teach the method of claim 1, wherein the user interactions comprise at least one of resource selections, line data, pointing device selections and keyboard data (column 6, lines 30-40).

As per claims 7 and 44, Himmel et al teach the method of claim 1, further comprising the step of adapting parameters of a user profile in response to the user interactions (column 8, lines 39-59).

As per claims 8, 13 and 45, Himmel et al teach the method of claim 1, wherein each of the iteratively stored user interactions are stored in respective chain stack records, the book mark comprising a linked list of the chain stack records (column 1, line 35 – column 2, line 11).

As per claims 9, and 46, Himmel et al teach the method of claim 8, wherein the user may reset the list of chain stack records (column 8, lines 39-59).

As per claim 11, Himmel et al teach the method of claim 10, wherein the executed selections are formed by storing, for each resolved resource, user input resulting in the transmission of data to a server (column 1, lines 40-67; column 7, lines 23-29).

As per claim 12, Himmel et al teach the method of claim 10, wherein the executed selections are formed by storing, for each resolved resource are transmitted to an applet. However, Himmel et al in view of Kim do not teach that it is transmitted to an applet. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit it to an applet so that it will be transparent to the user.

As per claim 28, 29, 32, 34, and 36, Himmel et al in view of Kim teach the URL of claim 25. Kim teaches an event list that is generated that contains content and type of navigation selection by the user (column 12, lines 39-65). Although Kim does not specify that there is a next record field, however, the nature of a list is that it is followed in a sequence, so the next field will naturally be the next navigation selection.

Claims 4-6, 17, 24, 27, 37, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al (6,212,522 B1) in view of Kim (US 6,546,002 B1), further in view of De Greef et al (US 6,549,217 B1).

As per claims 4, 17, 37, and 41, Himmel in view of Kim teach the method of claims 4 and 41. However, Neither Himmel nor Kim teach that the bookmark includes a display window size identifier. However, De Greef et al teach that the bookmark includes a display window size identifier (column 2, lines 55-60; column 9, lines 30-45).

As per claim 5 and 42, Himmel in view of Kim teach the method of claims 4 and 41. However, Neither Himmel nor Kim teach that user interactions comprising pointing device selections have associated with them pixel positions within the display window. However, De Greef et al teach that user interactions comprising pointing device selections have associated with them pixel positions within the display window (column 2, lines 55-60; column 9, lines 30-45).

As per claim 6, 24, 27, and 43, Himmel in view of Kim teach the method of claim 1. However, Neither Himmel nor Kim teach that user interactions comprising pointing device selections are defined in terms of pixel coordinates. However, De Greef et al teach that user interactions comprising pointing device selections are defined in terms of location (column 15, lines 25-65; column 9, lines 30-45).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

“System and Method for Remotely Grouping Contents of an Action History of a Stack”, Selesky et al, US Patent No. 5,m890,181. This reference teaches the history of a user's navigation on a site that is stored as a stack and may be used as a bookmark in order to eliminate the user having to navigate through the list of sites repeatedly.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shabana Qureshi whose telephone number is (571) 272-3990. The examiner can normally be reached on Monday - Thursday, 9:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shabana Qureshi
Examiner
Art Unit 2155

SQ
March 19, 2005


MOHAMMAD ALAM
EXAMINER